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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,686	02/20/2004	Pierre Blanchard	249181US	3668
22850	7590	10/02/2006		
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1714				

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/781,686

Applicant(s)

BLANCHARD ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/22/06 & 6/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14-37 and 40-45 is/are pending in the application.
- 4a) Of the above claim(s) 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-18, 35-37 and 40-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/22/06 and 6/22/06 has been entered.

The amendment of 3/22/06 has been entered. Claims 1-9, 14-37, and 40-45 are pending. Claims 19-34 remain withdrawn from consideration as being directed to an invention that is independent or distinct from the invention originally claimed, as stated in the office action of 2/24/05. An RCE must be directed to the same invention by definition. See MPEP 818.02(a)

#### By Originally Presented Claims

Where claims to another invention are properly added and entered in the application before an action is given, they are treated as original claims for purposes of restriction only.

The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-9, 14-18, and 35-45 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5533678 Strauch et al. with Hertz, Jr., "An Analysis of Rubber Under Strain From An Engineering Perspective", Elastomerics, Dec. 1991 cited as evidence.

Strauch discloses the instantly claimed calcium carbonates at the abstract. Column 4, lines 57-62 falls within the scope of the instant claims 7-8 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. The burden is on the applicant to provide proof to the contrary in that the PTO has no experimental facilities. The examiner has not used the applicant's own teachings against them as this rejection is based on the above cited patentee. The inherency above is not based on possibilities but the expectation that the BET surface area referenced will necessarily give the instantly claimed oil absorption as is clearly stated above. No evidence to the contrary is presented. The applicant's argument that the patentee "does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed" is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner.

Applicant's attempt to place the burden on the examiner relating to the different standard BETs is not persuasive. The examiner has no experimental facilities, as the applicant's

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representative is well aware. The two tests give the same BET surface area and are therefore taken to give the same values. There is no probative evidence to the contrary. There is no probative evidence to the contrary relative to the prima facie expectation that two calcium carbonates of equivalent surface area would be expected to necessarily absorb the instantly claimed amount of oil. Again, the examiner cannot provide experimental data. It is well established at this point that the case law places this burden on the applicant since the examiner's expectation is, on its face, a reasonable one.

It is not seen that the particles of Strauch et al. do not necessarily have the newly claimed viscosity behavior in some pvc plastisol encompassed by the newly claimed parameter. It is noted first that the pvc plastisol encompasses an infinite array of plastisols merely considering the identities of the plasticizer used, the molecular weight of the pvc, the particle sizes of the precipitated calcium carbonate, and the concentration of the pvc. Each of these parameters will affect the viscosity of the test materially based at least on the real life versions of Einstein's famous equation of viscosity, which are well known and found in textbooks. I first saw it in my physical chemistry book in undergraduate school. The modified equations of Guth listed under the "Fillers" subtitle of Hertz's article makes it clear that the volume of the particles and their shape affect viscosity. It is thus predictable to the ordinary skilled artisan that choosing particles of proper size and shape for the precipitated calcium carbonate relative to the particles of the prior art will give the required viscosity reduction. Thus, one could change the shape and size of the not well defined particles of the applicant's nebulous test so as to meet the required viscosity reduction by using the particles of the prior art with particles of the test modified so as to give the predictable viscosity lowering. The applicant's arguments and the Haldemann declaration of

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6/22/06 have been fully considered but they do not address this issue. This rejection is therefore maintained.

5. Claims 1, 5-9, 14-18, and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5533678 Strauch et al..

Strauch discloses the instantly claimed calcium carbonates at the abstract. Column 4, lines 57-62 falls within the scope of the instant claims 7-8 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee’s calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed calcium carbonates as those of the patentee because the patentee encompasses the instantly claimed calcium carbonates and they would have been expected to perform as described by the patentee. The burden is on the applicant to provide proof to the contrary in that the PTO has no experimental facilities. The examiner has not used the applicant’s own teachings against them as this rejection is based on the above cited patentee. The inherency above is not based on possibilities but the expectation that the BET surface area referenced will necessarily give the instantly claimed oil absorption as is clearly stated above. No evidence to the contrary is presented. The applicant’s argument that the patentee “does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed” is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner.

Applicant's attempt to place the burden on the examiner relating to the different standard BETs is not persuasive. The examiner has no experimental facilities, as the applicant's representative is well aware. The two tests give the same BET surface area and are therefore taken to give the same values. There is no probative evidence to the contrary. There is no probative evidence to the contrary relative to the prima facie expectation that two calcium carbonates of equivalent surface area would be expected to necessarily absorb the instantly claimed amount of oil. Again, the examiner cannot provide experimental data. It is well established at this point that the case law places this burden on the applicant since the examiner's expectation is, on its face, a reasonable one.

It is not seen that the particles of Strauch et al. do not necessarily have the newly claimed viscosity behavior in some pvc plastisol encompassed by the newly claimed parameter. It is noted first that the pvc plastisol encompasses an infinite array of plastisols merely considering the identities of the plasticizer used, the molecular weight of the pvc, the particle sizes of the precipitated calcium carbonate, and the concentration of the pvc. Each of these parameters will affect the viscosity of the test materially based at least on the real life versions of Einstein's famous equation of viscosity, which are well known and found in textbooks. I first saw it in my physical chemistry book in undergraduate school. The modified equations of Guth listed under the "Fillers" subtitle of Hertz's article makes it clear that the volume of the particles and their shape affect viscosity. It is thus predictable to the ordinary skilled artisan that choosing particles of proper size and shape for the precipitated calcium carbonate relative to the particles of the prior art will give the required viscosity reduction. Thus, one could change the shape and size of the not well defined particles of the applicant's nebulous test so as to meet the required viscosity

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reduction by using the particles of the prior art with particles of the test modified so as to give the predictable viscosity lowering. The applicant's arguments and the Haldemann declaration of 6/22/06 have been fully considered but they do not address this issue. This rejection is therefore maintained.

6. Claims 1- 9, 15-18, and 35-45 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5896904 Ozaki et al..

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. No evidence to the contrary is presented. The applicant's argument that the patentee "does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed" is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner. No probative evidence is seen that the disclosed nitrogen absorption does not necessarily give the instantly claimed surface areas and oil absorptions.

Applicant's attempt to place the burden on the examiner relating to the different standard BETs is not persuasive. The examiner has no experimental facilities, as the applicant's representative is well aware. The two tests give the same BET surface area and are therefore taken to give the same values. There is no probative evidence to the contrary. There is no probative evidence to the contrary relative to the prima facie expectation that two calcium carbonates of equivalent surface area would be expected to necessarily absorb the instantly claimed amount of oil. Again, the examiner cannot provide experimental data. It is well



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established at this point that the case law places this burden on the applicant since the examiner's expectation is, on its face, a reasonable one.

It is not seen that the particles of Ozaki et al. do not necessarily have the newly claimed viscosity behavior in some pvc plastisol encompassed by the newly claimed parameter. It is noted first that the pvc plastisol encompasses an infinite array of plastisols merely considering the identities of the plasticizer used, the molecular weight of the pvc, the particle sizes of the precipitated calcium carbonate, and the concentration of the pvc. Each of these parameters will affect the viscosity of the test materially based at least on the real life versions of Einstein's famous equation of viscosity, which are well known and found in textbooks. I first saw it in my physical chemistry book in undergraduate school. The modified equations of Guth listed under the "Fillers" subtitle of Hertz's article makes it clear that the volume of the particles and their shape affect viscosity. It is thus predictable to the ordinary skilled artisan that choosing particles of proper size and shape for the precipitated calcium carbonate relative to the particles of the prior art will give the required viscosity reduction. Thus, one could change the shape and size of the not well defined particles of the applicant's nebulous test so as to meet the required viscosity reduction by using the particles of the prior art with particles of the test modified so as to give the predictable viscosity lowering. The applicant's arguments and the Haldemann declaration of 6/22/06 have been fully considered but they do not address this issue. This rejection is therefore maintained.

7. Claims 1-9, 15, and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5896904 Ozaki et al..

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee’s calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9.

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language “around”. The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee’s calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed calcium carbonates as those of the patentee because the patentee encompasses the instantly claimed calcium carbonates and they would have been expected to perform as described by the patentee. The applicant’s argument that the patentee “does not describe selecting natural calcium carbonate in preparing rheology regulator as claimed” is not persuasive since the applicant has not shown such natural calcium carbonate to be different than that of the patentee in any probative manner. No probative evidence is seen that the disclosed nitrogen absorption does not necessarily give the instantly claimed surface areas and oil absorptions.

Applicant’s attempt to place the burden on the examiner relating to the different standard BETs is not persuasive. The examiner has no experimental facilities, as the applicant’s representative is well aware. The two tests give the same BET surface area and are therefore taken to give the same values. There is no probative evidence to the contrary. There is no

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probative evidence to the contrary relative to the prima facie expectation that two calcium carbonates of equivalent surface area would be expected to necessarily absorb the instantly claimed amount of oil. Again, the examiner cannot provide experimental data. It is well established at this point that the case law places this burden on the applicant since the examiner's expectation is, on its face, a reasonable one.

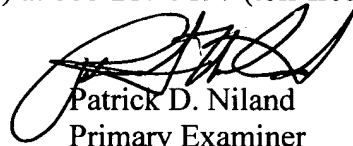
It is not seen that the particles of Ozaki et al. do not necessarily have the newly claimed viscosity behavior in some pvc plastisol encompassed by the newly claimed parameter. It is noted first that the pvc plastisol encompasses an infinite array of plastisols merely considering the identities of the plasticizer used, the molecular weight of the pvc, the particle sizes of the precipitated calcium carbonate, and the concentration of the pvc. Each of these parameters will affect the viscosity of the test materially based at least on the real life versions of Einstein's famous equation of viscosity, which are well known and found in textbooks. I first saw it in my physical chemistry book in undergraduate school. The modified equations of Guth listed under the "Fillers" subtitle of Hertz's article makes it clear that the volume of the particles and their shape affect viscosity. It is thus predictable to the ordinary skilled artisan that choosing particles of proper size and shape for the precipitated calcium carbonate relative to the particles of the prior art will give the required viscosity reduction. Thus, one could change the shape and size of the not well defined particles of the applicant's nebulous test so as to meet the required viscosity reduction by using the particles of the prior art with particles of the test modified so as to give the predictable viscosity lowering. The applicant's arguments and the Haldemann declaration of 6/22/06 have been fully considered but they do not address this issue. This rejection is therefore maintained.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland  
Primary Examiner  
Art Unit 1714